

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/845,737
Confirmation No.3462
Filing Date April 30, 2001
Inventorship Murren et al.
Applicant..... General Electric Company
Group Art Unit2154
Examiner Swearingen, J.
Attorney's Docket No.GE1-006US
Title: Architecture and Process for Presenting Application Content to Clients

PETITION TO THE DIRECTOR UNDER 37 CFR 1.181

To: MS Petition
Honorable Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

From: Nathan T. Grebasch (Tel. 509-324-9256; Fax 509-323-8979)
Lee & Hayes, PLLC
421 W. Riverside Avenue, Suite 500
Spokane, WA 99201

STATUS OF APPLICATION

Applicant responded to the Final Action, dated August 9, 2006, on February 9, 2007. Concurrently, Applicant filed a Notice of Appeal and an Appeal Brief will be filed in due course.

INTRODUCTION AND BASIS FOR PETITION

This petition is taken from the Advisory Action dated March 6, 2007 in which the Examiner denied Applicant's request for reconsideration as to the following matters (1) Requirement for Information under 37 CFR 1.105; (2) Requirement for a Substitute Specification under 37 CFR 1.125; and (3) Objection

to the Drawings under “37 CFR 1.81(a)”. Applicant respectfully requests relief under *M.P.E.P.* §§1002.02 and 1002.02(c) from the Examiner’s decision. This Petition is timely under 37 CFR 1.181(f) as the Applicant requested reconsideration of the Examiner decision in the paper filed February 9, 2007. As discussed herein, some of the above matters are entwined with subject matter which is properly the subject of an Appeal to the Board of Patent Appeals and Interferences (hereinafter, “the Board”). While the Board retains jurisdiction over the coextensive appeal subject matter, Applicant seeks to invoke the Director’s supervisory authority in the above matters. Applicant reserves the right to pursue an appeal on the patentability issues discussed herein in accordance with 35 U.S.C. § 134 and *M.P.E.P.* §1201.

REMARKS

Applicant requests the Director invoke supervisory authority in the below matters, and remove the Requirements/Objections discussed herein.

OVERVIEW

(1) Requirement for Information under 37 CFR 1.105 is improper and should be removed for at least the following reasons.

A) The Examiner’s requirement is improper under *M.P.E.P.* §704.11 as the request does not clearly focus on the reason for the requirement, and the scope of the expected response. Further, the request is not narrowly defined and the Examiner has not provided a “reasonable basis for requiring information.” While

the Examiner has not specifically requested information in the Final Action, the Examiner's contentions seem to aver that this Requirement is pending.

B) The record in the case supports the Applicant's position as the Examiner issued a Restriction Requirement, prior to Issuing the Requirement for Information, which failed to note any difficulty in comprehending the subject matter.

C) Applicant has met the Requirement for Information under 37 CFR 1.105 and 37 CFR 1.56.

(2) Requirement for a Substitute Specification under 37 CFR 1.125 is improper and should be removed for at least the following reasons.

A) The Examiner has not provided an adequate basis under 37 CFR 1.125(a) for the Requirement. Additionally, the Examiner's contention that the Specification fails to meet 35 U.S.C. §112, paragraph one is ripe for appeal.

(3) Objection to the Drawings under "37 CFR 1.81(a)" is improper and should be removed for at least the following reasons.

A) The Examiner incorrectly cited "37 CFR 1.81(a)" as the basis for the Objection. Due to the Examiner's erroneous assertion of "37 CFR 1.81(a)" (i.e., the drawings are "necessary" under the first sentence of 35 U.S.C. §113), this matter is also subject to appeal to the Board.

1) The Office of Initial Patent Examination (OIPE) makes initial decisions as to the applicability of 35 U.S.C. §113 and thus, decisions with regard to 37 CFR 1.81(a). By passing the Application on for examination, the OIPE determined that the drawings met 35 U.S.C. §113 and 37 CFR 1.81(a).

B) The Examiner has not followed the guidance in M.P.E.P. § 608.02 (III) which states “A drawing is not required for a filing date under 35 U.S.C. §111 and 113 if the application contains; (A) at least one process claim including the term “process” or “method” in its introductory phrase;”

1) At least Claim 48, as filed, recited “A method”, so a drawing is not required in this case.

C) The Examiner has failed to provide a rationale why one of ordinary skill in the art cannot understand the drawings.

SPECIFIC REMARKS

(1) Requirement for Information under 37 CFR 1.105 is improper and should be removed for at least the following reasons.

A) The Examiner’s requirement is improper under M.P.E.P. §704.11 as the request does not clearly focus on the reason for the requirement, and the scope of the expected response. Further, the request is not narrowly defined and the Examiner has not provided a “reasonable basis for requiring information.” While the Examiner has not specifically requested information in the Final Action, the Examiner’s contentions seem to aver that this Requirement is pending. The relevant portion of the Final Action (Page 3) is reproduced for the Office’s convenience.

3. Applicant failed to give the Examiner adequate information about the nature of the invention in two responses to non-final office actions and two responses to requests for information under 37 CFR 1.105. Applicant chose to state voluminous amounts of case law in lieu of responding to the substantive issues presented by the Office – the specification as originally filed is incomprehensible to one of ordinary skill in the art and is broadly readable upon the inetd module of UNIX or any program developed with an object-oriented programming language. The Examiner initiated an interview in an attempt to ascertain the nature of the invention in order to further prosecution. After conducting an interview at the request of the Examiner, the Examiner is still unclear about the nature of the invention.
4. Until Applicant is willing to clarify on the record what the invention actually is for the Examiner, no reasonable search of the prior art can be undertaken. Several Senior Examiners have been consulted

The Examiner's contentions are flawed because, while 37 CFR 1.105 places a burden on the Applicant to provide "factual information" which may assist the Examiner, this section does not authorize a "fishing expedition" requiring the Applicant to explain the subject matter to the Examiner's subjective satisfaction. The Examiner's Final Action fails to specify what requested information has not yet been provided. Thus, while the Action of March 10, 2005 requested information listed in M.P.E.P. §704.11(a) (to which Applicant responded) the Final Action is not denominated as a request for pieces of factual information, but instead asks the Applicant to "clarify on the record what the invention is." This does not coincide with the "Examples of Information Reasonably Required" in M.P.E.P. §704.11(a).

This invitation to "clarify on the record what the invention is" would not entail the submission of independent objective factual information and may require the Applicant to formulate responses. Neither 37 CFR 1.1015 nor M.P.E.P. §704.11 obligate an applicant to formulate response.

Kindly be aware that, Applicant provided an Appendix cross-referencing claim terminology to passages within the Specification in conjunction with paper of April 28, 2006 and discussing the term “layer”.

B) The record in the case supports the Applicant’s position, as the Examiner issued a Restriction Requirement prior to Issuing the Requirement for Information. The Restriction Requirement failed to even suggest the Examiner had any difficulty in comprehending the subject matter.

The Examiner’s Restriction Requirement under 35 U.S.C. §121, which noted the classification for three different claim groups, did not even suggest that the language was “incomprehensible”, as later asserted by the Examiner.

C) Applicant has met the Requirement for Information under 37 CFR 1.105 and 37 CFR 1.56.

The Requirement in the March 10, 2005 Action (commencing on page 12) requested the following:

1. Please provide the title, citation and copy of each publication that any of the applicants relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the reliance placed on that publication in distinguishing the claimed subject matter from the prior art.
2. Please provide the names of any products or services that have incorporated the claimed subject matter, prior to the filing of the

instant application. *March 10, 2005 Action*, Page 13, paragraphs 46-48 (extracted).

In response to the Requirement, Applicant averred that “Applicant states that no publications were used to draft the claimed subject matter.” *Reply of March 10, 2005*, page 41.

In response to the Requirement 2, Applicant noted “. . . that a program referred to as GEtheSource incorporated logic that is related to the subject matter described in the present application. GEtheSource is a web-based asset management application developed for Global Electronics Solutions business of GE Commercial Equipment Finance (now GE Commercial Finance). The logic pertaining to the present application was deployed in GEtheSource prior to the filing date of the presentation application, but within the one year “grace period” permitted by 35 U.S.C. § 102(b).

In response to the Requirement for Information in the November 30, 2005 Action, Applicant noted that GEtheSource was tested and put into production after January 2001, which is well within the one year grace period of 35 U.S.C. §102(b), as the instant Application was filed in April of 2001. Applicant also provided the Office a copy of an Internet document which mentions a program referred to as GEtheSource.

As the Applicant has answered the Examiner’s specific requests, the Requirement for Information is improper because the additional requests may require a formulated response rather than the submission of objective “facts.”

Additionally, the above responses indicate the Application has made a good faith attempt to answer the Requirement for Information.

(2) Requirement for a Substitute Specification under 37 CFR 1.125 is improper and should be removed for at least the following reason.

The Examiner has not provided an adequate basis under 37 CFR 1.125(a) for the Requirement of a substitute specification. 37 CFR 1.125(a) is limited to situations in which entry of amendments makes reading the application difficult and does not permit the Examiner to require a Substitute Specification under 35 U.S.C. §112, paragraph one.

As the Examiner has incorrectly cited 35 U.S.C. §112, paragraph one for this proposition, this issue is also subject to Appeal to the Board.

37 CFR 1.125(a) recites

“If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims or any part thereof, be rewritten.”

For the Office's convenience, the Examiner's contention is reproduced below. As the Examiner contentions appear in Final Office Action, Page 8:

29. A substitute specification including the claims is required pursuant to 37 CFR 1.125(a) because of the following rejections under 35 U.S.C. 112 dealing with enablement and indefiniteness, in part because of the freedom Applicant has taken at being his own lexicographer, thus making multiple terms in the invention and claims difficult to understand. The substitute specification is also required to be in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b). The substitute specification filed must be accompanied by a statement that it contains no new matter.

As the Examiner has failed to provide an authorized basis under 37 CFR 1.125, the Requirement for Information should be withdrawn. Applicant is not obliged to do more than what the law requires. As 37 CFR 1.125 does not authorize a Substitute Specification in accordance with the Examiner's stated rationale, the requirement for a Substitute Specification is *per se* improper.

(3) Objection to the Drawings under "37 CFR 1.81(a)" is improper and should be removed for at least the following reasons.

A) The Examiner incorrectly cited "37 CFR 1.81(a)" as the basis for the Objection. Due to the Examiner's improper reliance on "37 CFR 1.81(a)" (i.e., the drawings are "necessary" under the first sentence of 35 U.S.C. §113), this matter is also properly subject to appeal to the Board. The relevant portion of the Examiner's Final Action is reproduced below for the Office's convenience. As stated at Final Action, Page 7:

28. The drawings are objected to because, though the drawings are comprehensive in nature and cover multiple aspects of the invention, the drawings still fail to convey to one of ordinary skill in the art what exactly is being accomplished by the invention. The closest drawing that the Examiner feels is to showing the actual usage of the invention, which is still unclear, is Figure 20, which shows a login prompt on a web page and a human translator. Even with these two items present in Figure 20, and the descriptions given for this and all other submitted drawings, the Examiner is not assisted in grasping the invention at all based upon the currently submitted drawings. Applicant is reminded of the necessary compliance with 37 CFR 1.81(a), which states *The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.* [Emphasis added by the Examiner.] Corrected drawing

The Examiner incorrectly contends that the basis of the drawing objection lies in “37 CFR 1.81(a)”. The Examiner is incorrect because as discussed in M.P.E.P. § 608.02 (III) “[a] drawing will be considered *necessary* under the first sentence of 35 U.S.C. §113 in all applications where the drawing is referred to in the specification and one or more figures have been omitted.” Emphasis added. Thus, the Examiner has ignored the Office’s own understanding of 35 U.S.C. §113, first sentence by invoking 37 CFR 1.81(a), which mirrors the first sentence of 35 U.S.C. §113.

1) The Office of Initial Patent Examination (OIPE) makes initial decisions as to the applicability of 35 U.S.C. §113, first sentence and thus, decisions with regard to 37 CFR 1.81(a). By passing the Application on for examination, the OIPE determined that the drawings met 35 U.S.C. §113 and 37 CFR 1.81(a).

For arguments sake, if we presume the Examiner has correctly applied 37 CFR 1.81(a), the Examiner failed to follow proper procedures in M.P.E.P. § 608.02 (III) or, in the alternative, failed to cite a proper basis in M.P.E.P. § 608.02 (IV).

B) The Examiner has not followed the guidance in M.P.E.P. § 608.02 (III) which states “A drawing is not required for a filing date under 35 U.S.C. §111 and 113 if the application contains; (A) at least one process claim including the term “process” or “method” in its introductory phrase;”

1) At least Claim 48, as filed, recited “A method”, so a drawing is not required in this case.

C) The Examiner has failed to provide any rationale, legal or factual, why one of ordinary skill in the art cannot understand the drawings.

The Examiner’s contentions fail to provide any rationale, legal or otherwise, to bolster the Examiner’s position. The Examiner contentions failed to give a factual reason why the drawings are deficient. Instead, the Examiner merely jumps to the conclusion that “the drawings still fail to convey to one of ordinary skill in the art what exactly is being accomplished by the invention” instead of laying a factual or legal basis for support the Examiner’s position. Thus, Applicant is only provided the assertion “The drawings are objected to because, though the drawings are comprehensive in nature and cover multiple aspects of the invention, the drawings still fail to convey to one of ordinary skill in

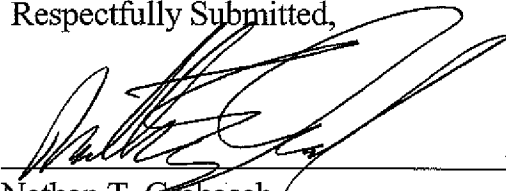
the art what exactly is being accomplished by the invention” rather than an explanation of why the drawings are not proper. *Final Action*, Page 7, lines 1-3.

For at least the foregoing reasons, the instant Petition should be granted. Applicant respectfully requests relief from the Examiner’s Requirements/Objections in the above matters. Should any issue remain that prevents granting this Petition the applicable PTO personnel are encouraged to contact the undersigned.

Respectfully Submitted,

Dated: 5.4.07

By: _____


Nathan T. Grebasch
Reg. No. 48,600
(509) 324-9256 x228